

REMARKS

Applicant has confirmed the oral election with traverse with the cancellation of the appropriate claims hereinabove.

The Examiner has rejected Claims 19-30 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Further, the Examiner has rejected Claims 1, 5, 7, 27, 34 and 38 under 34 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant respectfully asserts that such rejections are avoided in view of the clarifications made to each of the above rejected claims.

The Examiner has rejected Claims 1, 6-7, 19-20, 27, 34 and 39 under 35 U.S.C. 102(b) as being anticipated by AVG (AVG anti-virus) as evidence by Suffolk-L (<http://archiver.rootsweb.com/th/read/SUFFOLK/1999-05/0927040114>), Microscopy (Microscopy ListServer Archives, <http://www.msa.microscopy.com/cgi-bin/ReadPrintEmailHTML.pl?filename=9905.txt>, 2<sup>nd</sup> email) and Listserv (<http://listserv.uark.edu/scripts/wa.exe?A2=ind9912c&L=sag-l&F=&S=&P=2411>, 2<sup>nd</sup> email). Applicant respectfully disagrees with such rejection, especially in view of the amendments made to independent Claims 1, 19, 27 and 34. Specifically, applicant has incorporated the subject matter of dependent Claims 7 and 8 into each of the independent claims.

With respect to former dependent Claim 7, presently incorporated into each of the independent claims, the Examiner has relied on AVG's disclosed web link to make a prior art showing of applicant's claimed "wherein the certificate includes a link to a web site describing the virus scanning performed on the e-mail." Applicant respectfully asserts that AVG simply discloses a web link to the general "home-page" web site of the manufacturer of the anti-virus system used to scan the email, and not a link to a web site describing the virus scanning performed on the e-mail, as claimed by applicant. Such general "home-page" web site of the manufacturer in no way includes such information.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. This criteria has simply not been met by the AVG reference, especially in view of the amendments made hereinabove.

Nevertheless, despite such paramount differences and in the spirit of expediting the prosecution of the present application, applicant has included the following claim language in each of the independent claims:

“wherein the certificate includes a link to a web site describing the virus scanning performed on the e-mail by including a type and a version of a virus scanner utilized in scanning the e-mail for viruses, in addition to information for reading a digital signature added to the e-mail if no viruses are found” (emphasis added - see Claims 1, 19, 27, and 34).

Thus, it is respectfully asserted that only applicant teaches and claims a link to a website describing the virus scanning performed on the e-mail “by including a type and a version of a virus scanner utilized in scanning the e-mail for viruses, in addition to information for reading a digital signature added to the e-mail if no viruses are found” (emphasis added), whereby the type and version of the virus scanner as well as information for reading a digital signature may be found at a central linked location on a network. AVG’s general “home-page” web site of the manufacturer in no way includes such information. Applicant has even reviewed such web-site to verify this fact.

With respect to former dependent Claim 8, presently incorporated into each of the independent claims, the Examiner has rejected the subject matter of such claim under 35

U.S.C. 103(a) as being unpatentable over AVG and Listserv in view of Fisher (U.S. Patent No. 5,311,591). Again, applicant respectfully disagrees with such rejection.

For example, the Examiner relies on Fisher's disclosure of a digital certificate being added to a program by a manufacturer of that program to verify that it has not been tampered with (see Col. 16, lines 9-23 from Fisher), to make a prior art showing of applicant's claimed "further comprising adding a digital signature to the e-mail if no viruses are found" (see this or similar, but not identical subject matter in each of the independent claims). Applicant respectfully asserts that adding a digital signature to the e-mail if no viruses are found during a scan is simply not disclosed by the Fisher reference, which only attaches a digital certificate to a program when it is initially manufactured (and thus would not even need a scan).

Still yet, the Examiner has further rejected Claims 2-3, 5, 21-24, 28-29 and 38 under 35 U.S.C. 103(a) as being unpatentable over AVG and Listserv in view of Official Notice. Applicant respectfully disagrees with such rejection.

With respect to dependent Claims 2, 23-24, 28-29, the Examiner has simply dismissed the same under Official Notice. In response, for example, applicant points out that neither AVG nor Listserv even suggest "wherein the computer sending the e-mail and the recipient computer are servers located within a computer network" (see dependent Claim 23). Applicant respectfully asserts that such claim language is advantageous since it allows for the option of the scanning being performed at a server, and then directly transmitting the scanned e-mail to another server.

Also, for example, neither reference suggests "wherein the certificate contains only graphical images" (see dependent Claim 24). Applicant again asserts that such claim language is advantageous since it allows for an e-mail to be certified via other than plain text, wherein AVG and Listserv only disclose utilization of plain text.

Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

In addition, with respect to Claims 3, 21 and 22, the Examiner has dismissed the same as simply being obvious to one of ordinary skill in the art given that it is well known. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the references do not teach ALL of the claim limitations. For example, applicant's claimed “wherein the computer sending the e-mail and the recipient computer are desktop computers” (see Claim 21) and “wherein one of the computer sending the e-mail and the recipient computer is a handheld computer” (see Claim 22) are simply not disclosed in the prior art relied upon by the Examiner. Applicant asserts that such claim language is not obvious since it allows for e-mails to be scanned in the manner claimed by applicant whether the “computer sending the e-mail and the recipient computer are desktop computers” or whether “one of the computer sending the e-mail and the recipient computer is a handheld computer”.

For the above reasons, a notice of allowance or a specific prior art showing of each of the claim limitations, in the context of the remaining elements, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 42-45 below, which have been added for full consideration:

"wherein the certificate includes a company logo" (see Claim 42);

"wherein the certificate includes an icon" (see Claim 43);

"wherein the e-mail and at least one attachment is scanned for viruses" (see Claim 44); and

"wherein the virus scanner is incorporated within a mail application that is utilized in creating the e-mail" (see Claim 45).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAIIP140/01.131.01).

Respectfully submitted,  
Zilka-Korab, PC.

Kevin J. Zilka  
Registration No. 41,429

P.O. Box 721120  
San Jose, CA 95172-1120  
408-505-5100